IPW

OIPE JC174
OCT 18 2004
PATENT & TRADEMARK OFFICE

OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.

ATTORNEYS AT LAW

Docket No.: 244088US2

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/685,494
Applicants: Yukio TANIGUCHI, et al.
Filing Date: October 16, 2003
For: METHOD AND APPARATUS FOR FORMING PATTERN ON THIN SUBSTRATE OR THE LIKE
Group Art Unit: 2851
Examiner: NGUYEN, HUNG

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of **$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Registration No. 25,599

Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850
(703) 413-3000 (phone)
(703) 413-2220 (fax)

GJM/JW/agm
I:\ATTY\JW\244088US\244088US PTO COV.DOC

OIPE JC17
OCT 18 2004
PATENT & TRADEMARK OFFICE

DOCKET NO: 244088US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:	
YUKIO TANIGUCHI, ET AL.	:	EXAMINER: NGUYEN, HUNG
SERIAL NO: 10/685,494	:	
FILED: OCTOBER 16, 2003	:	GROUP ART UNIT: 2851
FOR: METHOD AND APPARATUS FOR FORMING PATTERN ON THIN SUBSTRATE OR THE LIKE	:	

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election Requirement dated September 16, 2004, Applicants elect with traverse Group I, Claims 1-10 drawn to an exposure device. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicants respectfully traverse this Restriction Requirement for the reason that the inventions of Groups I and II have not been shown to be distinct in the manner required by M.P.E.P. §806.05(e).

As the noted portion of the M.P.E.P. indicates, the Patent Office must demonstrate either (1) that the process as claimed can be practiced by another materially different apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another and materially different process.

Page 2 of the Restriction Requirement indicates that "the process as claimed can be practiced by another different apparatus such as a flat bed scanner." However, the specific steps of the process proposed in the Office Action are not given. Thus, Applicants can not determine if the process proposed is materially different than that of the claimed invention.

Thus, since the Restriction Requirement fails to set forth a materially different process which can be practiced with the apparatus of Claim 1, the Restriction Requirement cannot be said to have met the requirement of MPEP §806.05(e).

Furthermore, MPEP § 803 states:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would clearly be burdensome on Applicants to be required to file, prosecute and maintain separate applications and patents on the identified.

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-20 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Attorney of Record
Registration No. 25,599

Raymond F. Cardillo, Jr.
Registration No, 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

GJM/JW
I:\ATTY\JW\2440088US\244088US_ELECTION.DOC